REMARKS

Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-95 are pending in this application. Claims 93, 94, and 95 are added herein. Support for new claims 93, 94, and 95 is described in the specification at page 28, lines 18-25, continuing at page 29, lines 1-7, page 31, lines 8-25, continuing at page 32, lines 1-10, and is shown in Fig. 15. Reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments, and the withdrawal of the previous grounds of rejection. Further favorable reconsideration is requested.

Claim Rejections – 35 U.S.C. § 102:

Claims 56, 71, and 86 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2002/0152245 to McCaskey (hereinafter "McCaskey"). The rejection is traversed.

The third clauses of claims 56, 71, and 86 recite substantially:

A receiving unit that receives a specification from the client computer in response to the summary.

McCaskey neither teaches, discloses, nor suggests, "a receiving unit that receives a specification from the client computer in response to the summary," as recited substantially in claims 56, 71, and 86. No specification is sent "from the client computer in response to the summary" in McCaskey.

In McCaskey, rather, a subscriber *first* specifies a plurality of selection criteria for news topics for electronic mail presentation, and *then* news information extracted according to subscriber selection criteria is sent to the subscriber. In particular, as recited in claim 62:

62. The method of claim 61 wherein the step of selecting and sending news information to news subscribers via electronic mail, further comprises: providing a means for a plurality of subscribers to request electronic mail presentation of news information, providing a means for a subscriber to specify a plurality of selection criteria for news topics for electronic mail presentation, extracting news information according to subscriber selection criteria, preparing an electronic mail message for each subscriber requesting electronic mail presentation of news information, and transmitting the electronic mail messages to all subscribers requesting electronic mail presentation of news information.

Since, in McCaskey, a subscriber specifies a plurality of selection criteria for news topics for

electronic mail presentation, after which news information extracted according to subscriber selection criteria is sent to the subscriber, McCaskey is not receiving "a specification from the client computer in response to the summary," as recited substantially in claims 56, 71, and 86.

Furthermore, in McCaskey, statistics concerning electronic mail users and their selections of news topics are combined with subscriber preferences stored in electronic mail user's database 460 to *create* statistics for the administrator 151 to use. No specification is solicited from the subscriber at all. In particular, as described at paragraph [0176]:

> Administrator 151 also uses a set of statistics Web pages 171 to review statistics concerning electronic mail users and their selections of news topics. Statistics program 351 combines the set of topics from topic table 405 in editorial database 400 with subscriber preferences stored in electronic mail users database 460 to create its statistics for administrator use.

Since no specification is sent "from the client computer in response to the summary" in McCaskey, McCaskey is not receiving "a specification from the client computer in response to the summary," as recited substantially in claims 56, 71, and 86.

Moreover, in McCaskey, the news selections specified by each user are maintained in the electronic mail user's database 460, at a separate website. In particular, as described at paragraph [0177]:

> The electronic mail subscriber controls his or her own subscription through Web access to a separate Website, which maintains the electronic mail address and the news selections specified by each user in the electronic mail users database 460.

Since, in McCaskey, the news selections specified by each user are maintained in the electronic mail users database 460, at a separate website, McCaskey is not receiving "a specification from the client computer in response to the summary," as recited substantially in claims 56, 71, and 86.

The fourth clauses of claims 56, 71, and 86 recite substantially:

> An extracting unit that extracts a plurality of electronic articles from the article database based on the specification.

McCaskey neither teaches, discloses, nor suggests "an extracting unit that extracts a plurality of electronic articles from the article database based on the specification," as recited substantially in claims 56, 71, and 86. In McCaskey, rather, the news electronic mail program 358 generates news electronic mail messages 178 for each user from the contest Web pages 173, the announcement Web pages 174, the weather Web pages 175, and all current day headline

information 180 created for electronic mail use by publish program 133. None of the statistics concerning electronic mail users and their selections of news topics that were reviewed by the administrator 151 are used to generate news electronic mail messages 178 for the users. In particular, as described at paragraph [0179]:

> News electronic mail program 358 reads contest Web pages 173, announcement Web pages 174, weather Web pages 175, and all current day headline information 180 created for electronic mail use by publish program 133. News electronic mail program 358 then reads the list of electronic mail subscribers stored in electronic mail users database 460, generates news electronic mail messages 178 for each user, and mails the messages out to the users 3 via the World Wide Web 40.

Since, in McCaskey, the news electronic mail program 358 generates news electronic mail messages 178 for each user from the contest Web pages 173, the announcement Web pages 174, the weather Web pages 175, and all current day headline information 180 created for electronic mail use by publish program 133, McCaskey is not extracting "a plurality of electronic articles from the article database based on the specification," as recited substantially in claims 56, 71, and 86. Claims 56, 71, and 86 are submitted to be allowable. Withdrawal of the rejection of claims 56, 71, and 86 is earnestly solicited.

Claim Rejections – 35 U.S.C. § 103:

Claims 44, 46-50, 52-55, 57, 59-64, 66-70, 72, 74-79, 81-85 and 87-92 are rejected under 35 U.S.C. §103(a) as being unpatentable over McCaskey in view of U.S. Patent No. 5,740,549 to Reilly (hereinafter "Reilly").

The third clauses of claims 44, 50, 57, 64, 72, and 79 recite substantially:

Receiving a specification from the client computer in response to the summary.

McCaskey neither teaches, discloses, nor suggests "receiving a specification from the client computer in response to the summary," as discussed above with respect to the rejection of claims 56, 71, and 86. Reilly does not either, and thus cannot make up for the deficiencies of McCaskey with respect to claims 44, 50, 57, 64, 72, and 79.

In Reilly, rather, the subscriber sets up a profile, including categories of topics of interest, and the system, not the subscriber, selects the articles to be displayed on the subscriber's computer accordingly. In particular, as described at column 2, lines 49-53:

> Another goal of the present invention is provide each subscriber with the ability to set up and change a user profile indicating categories and subcategories of topics which are of interest and not of interest to the subscriber, and to select the

news stories displayed on the subscriber's computer accordingly.

Since, in Reilly, the system, not the subscriber, selects the articles to be displayed on the subscriber's computer, Reilly is not "receiving a specification from the client computer in response to the summary," as recited substantially in claims 44, 50, 57, 64, 72, and 79.

Furthermore, even if the user profile set up by the subscriber in Reilly were considered to be equivalent to the recited specification, it still would not be received "from the client computer in response to the summary," as recited substantially in claims 44, 50, 57, 64, 72, and 79. Rather, in Reilly, the summary, i.e. the news stories displayed on the subscriber's computer, would be selected to suit the topics listed in the subscriber's *profile*, not the other way around.

Similarly, even if the primary components, i.e. the headlines of the news stories in Reilly were considered to be equivalent to the recited summary, and displaying the secondary component of a news story in Reilly upon a subscriber's request was considered to be equivalent to the recited specification, the subscriber's request would still not be received "from the client computer in response to the summary," as recited substantially in claims 44, 50, 57, 64, 72, and 79.

Rather, in Reilly, each news item displayed in the center section 248 of the data viewer's display *includes* both the primary and secondary portions of the news item. Thus, *both* the primary *and* the secondary components of each news story are already *on* the client computer, and there is no need to send back to the information server for the secondary component in order to display that as well. In particular, as described at column 13, lines 49-60:

> Each news item displayed in the center section 248 of the data viewer's display includes both the primary and secondary portions of the news item, thereby providing the subscriber in most instances with access to a fuller version of the news item than was shown by the screen saver. In the case of very short news items, the entire news item may be contained in its primary component. Furthermore, in client computers with very limited hard disk space available for storing news items, as indicated by the user profile 194 for the client computer, the secondary component of news items may not be stored in the local information database in order to conserve disk space.

Since, in Reilly, each news item displayed in the center section 248 of the data viewer's display includes both the primary and secondary portions of the news item, Reilly is not "receiving a specification from the client computer in response to the summary," as recited substantially in claims 44, 50, 57, 64, 72, and 79.

The fourth clauses of claims 44, 50, 57, 64, 72, and 79 recite substantially:

Extracting a plurality of electronic articles from the article database based on the

specification.

McCaskey neither teaches, discloses, nor suggests "extracting a plurality of electronic articles from the article database based on the specification," as discussed above with respect to the rejection of claims 56, 71, and 86. Reilly does not either, and thus cannot make up for the deficiencies of McCaskey with respect to claims 44, 50, 57, 64, 72, and 79.

In Reilly, rather, even if the primary components, i.e. the headlines of the news stories were considered to be equivalent to the recited summary, and displaying the secondary component of a news story in Reilly upon a subscriber's request were considered to be equivalent to the recited specification, a subscriber may still only request that the secondary component of a news article be *displayed*, as discussed above, not extract "a plurality of electronic articles from the article database based on the specification," as recited substantially in claims 44, 50, 57, 64, 72, and 79. Thus, even if McCaskey and Reilly were combined, as proposed in the Office Action, claims 44, 50, 57, 64, 72, and 79 would not result. Claims 44, 50, 57, 64, 72, and 79 are thus submitted to be allowable. Withdrawal of the rejection of claims 44, 50, 57, 64, 72, and 79 is earnestly solicited.

Claims 46-49, 87 and 88; 52-55; 59-63, 89, and 90; 66-70; 74-78, 91, and 92; and 81-85 depend from claims 44, 50, 57, 64, 72, and 79, respectively, and add further distinguishing elements. Claims 46-49, 87 and 88; 52-55; 59-63, 89, and 90; 66-70; 74-78, 91, and 92; and 81-85 are thus also submitted to be allowable. Withdrawal of the rejection of claims 46-49, 87 and 88; 52-55; 59-63, 89, and 90; 66-70; 74-78, 91, and 92; and 81-85 is earnestly solicited.

New claims 93, 94, and 95:

Claims 93, 94, and 95 depend from claim 50, claim 64, and claim 79, respectively, and add further distinguishing elements. Claims 93, 94, and 95, for example, recite:

> Wherein the second specification comprises a reply electronic mail including a keyword.

Neither McCaskey nor Reilly teach, disclose, or suggest "wherein the second specification comprises a reply electronic mail including a keyword." Claims 93, 94, and 95 are thus believed to be allowable.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-95 are allowable over the cited references. Allowance of

all claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-95 and of this entire application is therefore respectfully requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.
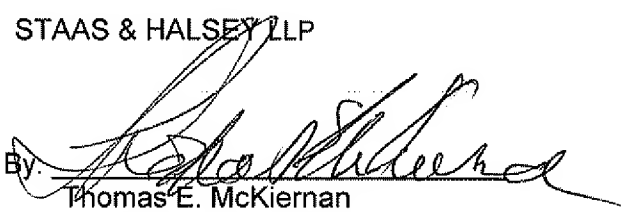
If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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